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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte THOMAS TALANIS and FRANK VOLKMANN

_____

Appeal 2009-003715
Application 10/524,782
Technology Center 2100

_____

Decided: January 26, 2010

_____

Before LEE E. BARRETT, JAY P. LUCAS, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the
Examiner's final rejection of claims 19-37. Claims 1-18 have been
cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

<center>STATEMENT OF THE CASE</center>

<center>THE INVENTION</center>

Appellants' invention relates generally to an apparatus. More particularly, the invention on appeal is directed to an automation device having a file directory structure which is stored in a file. (Spec. 1, para. [0002]).

Claim 19 is illustrative:

19.   An apparatus configured to receive files and updates thereto through a communication network, with the files assembled in a file directory structure, the apparatus being responsive to control operation of a device according to one or more of the files, the apparatus including storage for storing the file directory structure, the file directory structure including:

a first hierarchy level and a second hierarchy level designed as a subordinate level of the first hierarchy level;

a first file directory situated on the first hierarchy level;

a second file directory situated on the second hierarchy level; and

a first file situated on the first or the second hierarchy level or on a subordinate hierarchy level, wherein

the file directory structure is held in a second file, wherein

each file directory and each file of the file directory structure is listed consecutively in the second file, wherein each file directory and each file of the file directory structure is identified by at least one characteristic start symbol and/or at least one characteristic end

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symbol, and wherein the contents of each file directory and each file in the file directory structure are stored in each case between the respective characteristic symbols,

said file directory structure enabling the apparatus to operate as a web server, thereby enabling remote access to control or change operation of the device.

PRIOR ART

The Examiner relies upon the following references as evidence:

Lenz	US 6,029,196	Feb. 22, 2000
Carpentier	WO 01/18633 A1	Mar. 15, 2001

THE REJECTION

The Examiner rejected claims 19-37 under 35 U.S.C. § 103(a) as unpatentable over the combination of Carpentier and Lenz.

APPELLANTS' CONTENTIONS

1. Appellants contend that the cited references fail to disclose a "device' as claimed. (App. Br. 6-7).

2. Appellants assert that Carpentier fails to disclose any specific hierarchical relationships. (App. Br. 9, para. 1).

3. Appellants assert that Carpentier fails to teach or suggest different hierarchical levels. (Id. at para. 2)

4. Appellants assert that the cited references fail to teach or suggest the limitation of "each file directory and each file of the file directory structure is identified by at least one characteristic start symbol and/or at least one characteristic end symbol." (Id. at para. 5).

5.   Appellants contend that the combination of Lenz and Carpentier is improper because it would require a reconstruction of Carpentier and the combination is a result of hindsight. (App. Br. 10-11).

ISSUES

Based upon our review of the administrative record, we have determined that the following issues are dispositive in this appeal:

1.   Have Appellants shown the Examiner erred in determining that the cited references teach or would have suggested an "apparatus being responsive to control operation of a device," as claimed?

2.   Have Appellants shown the Examiner erred in determining that the cited references teach or would have suggested the claimed specific hierarchical relationships? (App. Br. 9, para. 1).

3.   Have Appellants shown the Examiner erred in determining that the cited references teach or would have suggested the limitation of "each file directory and each file of the file directory structure is identified by at least one characteristic start symbol and/or at least one characteristic end symbol?"

4.   Have Appellants shown the Examiner erred by improperly combining the Lenz and Carpentier references under § 103?

<center>PRINCIPLES OF LAW</center>

<center>OBVIOUSNESS</center>

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

"What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103." *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 419 (2007). To be nonobvious, an improvement must be "more than the predictable use of prior art elements according to their established functions." *Id.* at 417.

> Invention or discovery is the requirement which constitutes the foundation of the right to obtain a patent . . . unless more ingenuity and skill were required in making or applying the said improvement than are possessed by an ordinary mechanic acquainted with the business, there is an absence of that degree of skill and ingenuity which constitute the essential elements of every invention.

Dunbar v. Myers, 94 U.S. 187, 197 (1876) (citing *Hotchkiss* v. *Greenwood*, 52 U.S. 248, 267 (1850)) (*Hotchkiss* v. *Greenwood* was cited with approval by the Supreme Court in *KSR*, 550 U.S. at 406, 415, 427).

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006). Therefore, we look to Appellants' Briefs to show error in the proffered prima facie case.

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FINDINGS OF FACT

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In our analysis *infra*, we rely on the following findings of fact (FF):

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THE CARPENTIER REFERENCE

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1.   Carpentier discloses a directory structure. Carpentier teaches that "[a] hierarchy of folders may be created, folder and directory attributes may be assigned and individual file attributes may be identified for assigning to particular files once these files are retrieved." (Pg. 25, ll. 4-6 and Fig. 5).

2.   Carpentier teaches a descriptor file. Any number of folders and any hierarchy may be represented in the descriptor file. (Pg. 16, ll. 21-23 and Fig. 3).

3.   Carpentier discloses a directory (folder name) "net" which is denoted by at least an end symbol (<!--net-->). The files within "net" (i.e., FtpClient.class, etc.) each have at least a start symbol, e.g., <file name= "FtpClient.class." (Fig. 6A).

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THE LENZ REFERENCE

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4.   Lenz is directed to a centralized configuration file system that allows the user to configure an entire network of clients from a centralized server. (Col. 1, ll. 51-55).

5.   Lenz discloses a client 102 sends a request for configuration to a server 103. The server 103 finds the requested configuration file and sends the configuration file to the client 102. (Col. 3, ll. 2-6).

6.   Lenz teaches the use of a Lightweight Directory Access
Protocol (LDAP) server. (col. 3, ll. 39-40).

ANALYSIS

We address Appellants' arguments in the order presented in the
principal Brief.

Issue 1

We decide the question of whether Appellants have shown the
Examiner erred in finding that the cited combination of Carpenter and Lenz
teaches or would have suggested an "apparatus being responsive to control
operation of a device," as claimed. Appellants aver that the Examiner must
show the obviousness of the claimed file directory structure enabling the
apparatus to operate as a web server. (Reply Br. 5, last paragraph).

We find that Lenz teaches an apparatus (server) being responsive to
control a device (client), as recited in the preamble of independent claim 19.
(FF 4). Lenz teaches that the server 103 receives (i.e., is responsive to)
configuration requests from the client(s) and configures the client(s) based
upon the requested configuration. (FF 5). We also note that Lenz teaches the
use of a Lightweight Directory Access Protocol (LDAP) server that we find
would have at least suggested (in combination with Carpentier) the claimed
file directory structure enabling the apparatus to operate as a web server. (FF
6.).

It is our view that Appellants' arguments do not take into account
what the collective teachings of the prior art would have suggested to one of
ordinary skill in the art and are therefore ineffective to rebut the Examiner's

prima facie case of obviousness. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981) ("The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.").

For at least the aforementioned reasons, we find Appellant has not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner's specific findings of fact regarding the argued limitations of an "apparatus being responsive to control operation of a device" and "said file directory structure enabling the apparatus to operate as a web server." (Claim 19).

Issue 2

We decide the question of whether the Examiner erred in determining that the combination of cited references (notably Carpenter) teaches or would have suggested the claimed specific hierarchical relationships.

We begin our analysis by noting Appellants' statement in the Reply Brief that "[t]he appellants do not suggest that they invented hierarchical structures, and the mere identification that such structures exist in the prior art provides no suggestion for that which is claimed." (Reply Br. 2). We do not agree for the reasons discussed *infra*.

We note that the Supreme Court has determined that the conclusion of obviousness *can* be based on the interrelated teachings of multiple patents, the effects of demands known to the design community or present in the

marketplace, and the background knowledge possessed by a person having ordinary skill in the art, and an obviousness "analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR*, 550 U.S. at 418. *See also Dystar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1368 (Fed. Cir. 2006).

In the present case, we find that Carpentier reasonably teaches or would have suggested that a file directory structure may be represented by any number of folders and *any hierarchy*. (FF 1-2). Therefore, we find that Carpentier suggests that a particular arrangement of hierarchical structures, as claimed by Appellants, is merely a combination of familiar elements that would have yielded a predictable result. (FF 1-3). The "combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR* 550 U.S. at 401.

Here, we find an artisan would have known that files and directories can be represented within any number of hierarchical levels or hierarchical relationships. Thus, Appellants' arguments that Carpentier does not disclose any specific hierarchical relationships (Reply Br. 2) are not persuasive since the Examiner need not show "precise teachings directed to the specific subject matter of the challenged claim" and can take into account "the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR*, 550 U.S. at 418. Therefore, we find that Appellants have not shown error in the Examiner's findings regarding the argued "specific hierarchical relationships." (App. Br. 9, para. 1).

Issue 3

We decide the question of whether Appellants have shown the Examiner erred in determining that the cited references teach or would have suggested the limitation of "each file directory and each file of the file directory structure is identified by at least one characteristic start symbol and/or at least one characteristic end symbol." (Claim 19). Appellants further contend that claim 19 requires that the contents of each file directory and each file in the directory are stored in each case between the respective characteristic symbols. (Reply Br. 3). In particular, Appellants aver that Carpentier does not illustrate that each file directory and each file is identified by at least one characteristic start symbol and/or at least one end symbol. (*Id.*). We do not agree for the reasons discussed *infra*.

We agree with the Examiner's findings with respect to the aforementioned limitation for essentially the same reasons set forth by the Examiner in the Answer. (Ans. 12). More specifically, we find that Figure 6A of Carpentier discloses a directory (folder name) "net" which is denoted by at least an end symbol (<!--net-->). The files within "net" (i.e., FtpClient.class etc.) each have at least a start symbol (<file name= "FtpClient.class"). We find the files within "net" illustrate and suggest a hierarchical relationship with "net." (See Carpentier Fig. 6A).

Therefore, we find that Appellants have not shown error in the Examiner's findings regarding the argued limitations of "each file directory and each file of the file directory structure is identified by at least one characteristic start symbol and/or at least one characteristic end symbol."

Issue 4

We decide the question of whether Appellants have shown the Examiner erred by improperly combining Carpentier and Lenz under § 103. Appellants contend that the Examiner's proffered combination is the result of impermissible hindsight. (App. Br. 19). As noted above, Appellants contend that the proffered combination would require a reconstruction of Carpentier. (App. Br. 10-11).

As discussed *supra*, we find Appellants' arguments do not take into account what the collective teachings of the prior art would have suggested to one of ordinary skill in the art and are therefore ineffective to rebut the Examiner's prima facie case of obviousness. *See Keller*, 642 F.2d at 425. Thus, we do not find persuasive Appellants contention that Carpentier would have to be reconstructed in order to be combined with Lenz.

While we are fully aware that hindsight bias often plagues determinations of obviousness, *Graham v. John Deere Co.*, 383 U.S. 1, 36 (1966), we are also mindful that the Supreme Court has clearly stated that the "combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results," *KSR* 550 U.S. at 401.

This reasoning is applicable here. Thus, it is our view that the Examiner's obviousness rejection takes into account what the combined teachings of Carpentier and Lenz would have suggested to one skilled in the art. Therefore, we find that Appellants have not shown the Examiner has improperly combined Carpentier and Lenz under § 103.

Dependent Claims 20-37

Regarding each dependent claim on appeal, we note that Appellants follow the general pattern of reciting the language of the claim followed by a conclusory statement that the limitation is not taught by the Examiner's cited prior art combination. (App. Br. 12-18). With the exception of claims 35 and 36 (where Appellants merely restate the Examiner's rejection) Appellants *fail to reference any specific citation to the prior art* in the context of a substantive argument explaining how the claim language is unobvious over the Examiner's proffered prior art combination of Carpentier and Lenz.

This form of argument is wholly ineffective in demonstrating error in the Examiner's prima facie case to establish the patentability of the claims on appeal. *See Ex parte Belinne*, No. 2009-004693, slip op. at 7-8 (BPAI Aug. 10, 2009) (informative), *available at* http://www.uspto.gov/web/offices/dcom/bpai/its/fd09004693.pdf

Based on this record, we find Appellants have not met their burden of showing specific error in the Examiner's findings of fact and ultimate legal conclusion of obviousness regarding dependent claims 20-37.

CONCLUSION

Based on the findings of facts and analysis above, Appellants have not shown the Examiner erred in determining the following:

Appellants have not shown the Examiner erred in finding that the cited references teach or would have suggested an "apparatus being responsive to control operation of a device," as claimed.

Appellants have not shown the Examiner erred in finding that the cited references teach or would have suggested the claimed specific hierarchical relationships.

Appellants have not shown the Examiner erred in determining that the cited references teach or would have suggested the limitation of "each file directory and each file of the file directory structure is identified by at least one characteristic start symbol and/or at least one characteristic end symbol."

Appellants have not shown the Examiner erred by improperly combining Lenz and Carpentier under § 103.

ORDER

We affirm the Examiner's decision rejecting claims 19-37 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

pgc

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